



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
---------------	-------------	----------------------	---------------------

08/154,019 11/16/93 DEBOER

18M2/1201

WILLIAM M. SMITH
TOWNSEND AND TOWNSEND KHOURIE AND CREW
STEUART STREET TOWER
ONE MARKET PLAZA, 20TH FLOOR
SAN FRANCISCO, CA 94105

H 146423122
EXAMINER

CHAMBERS, J

ART UNIT PAPER NUMBER

1804
DATE MAILED:

12/01/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire _____ month(s), thirty (30) days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-99 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☐ Claims _____ are rejected.
5. ☐ Claims _____ are objected to.
6. ☒ Claims 1-99 are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-28, 63-72, 75-81 and 84-95, drawn to a transgene, classified in Class 536, subclasses 23.1, for example.

II. Claims ~~29-40, 54~~, 73, 82, 83, ~~96~~ and 97, drawn to a transgenic bovine species and a method of making the same, classified in Classes 800 and 435, subclasses 2 and 172.3, respectively, for example.

III. Claims 41-53, drawn to milk from a transgenic bovine species, classified in Class 426, subclass 580, for example.

IV. Claims 55-62, drawn to a method of producing a transgenic non-human mammal having a desired phenotype, classified in Class 800, subclass 2, for example.

V. Claim 74, drawn to semen of a transgenic bovine, classified in Class 435, subclass 2, for example.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are patentably distinct species because the transgene of invention I is not limited in use to the preparation of the transgenic bovine species of invention II and can be used for gene therapy or the preparation of nucleic acids probes for hybridizations.

Inventions II and III are patentably distinct species because the transgenic bovine species of invention II is not limited in use to the production of the milk of invention III and can be used for the preparation of nucleic acids, proteins and other cellular products.

Inventions II and IV are patentably distinct species because the method of producing a transgenic non-human mammal having a desired phenotype of invention IV is not limited in use to the preparation of the transgenic bovine species of invention II and can be used for the preparation of other transgenic non-human mammals.

Inventions II and V are patentably distinct species because the transgenic bovine species of invention II is not limited in use to the production of the semen of invention V and can be used for the preparation of nucleic acids, proteins and other cellular products.

Inventions III and V are directed to milk and semen, respectively. Milk and semen are patentably distinct products obtainable from a transgenic bovine.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their divergent subject matter, fall into different statutory classes of invention, and are separately classified and searched, restriction for examination purposes as indicated is proper.

A telephone call was made to Mr. Joe Liebeschuetz on November 23, 1994 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Serial No. 08/154,019

-4-

Art Unit 1804

Any inquiry concerning this communication should be directed to
Jasemine C. Chambers, Ph. D., at telephone number 703-308-2035.

Jasemine C. Chambers
JASEMINE C. CHAMBERS
PRIMARY EXAMINER
GROUP 1800